



UNITED STATES DEPARTMENT OF COMMERCE
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08/615,814

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/615,814 03/14/96 JOHNSON

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33M1/0930

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ART UNIT	PAPER NUMBER
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3312

DATE MAILED:

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09/30/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on June 17, 1996

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-22 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-22 is/are rejected.

☒ Claim(s) 2, 4-7, 12, 16, 18, 19, & 21 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Claims 1-22 are rejected under the judicially created doctrine of double patenting over the claims of copending patent numbers 5533499, 5533503, 5549103, and 5476091. The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as is clearly seen by comparison of the claims. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP 804.

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The following is a quotation of the first paragraph of 35 U.S.C. § 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.

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The original disclosure is limited to a nasal dilator only. The disclosure is not generic to dilators for all human anatomy. In other words, applicant has only disclosed the subset of a nasal dilator from the possible set of dilators for all human anatomy. It is noted that this case purports to be a CON of 08/183,916. Yet the recitation of claim 8 for a human anatomy dilator is drawn to the subject matter of patent # 5476091, which was a CIP of the same 08/183,916.

Claim 8 is rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

- 5 *Claims 1-22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

10 Claim 1 lacks antecedent basis for "the deformable means". The scope of the claim is unknown - is the phrase "the inherent tendency of the truss member ... drawing in during breathing" supposed to be a 112, sixth paragraph limitation? The scope of claim 1 is also unclear because it is not known what the phrase "a resilient member ..."

15 ... refers to. Is applicant using "a resilient member..." to refer to the "resilient means 26" disclosed and illustrated? If so, the recitation of claim 2 of "a resilient means" provides a double recitation of structure. Also, in claim 1, is the last paragraph meant to be a 112, sixth paragraph limitation? See also claim 6. Is the second paragraph of claim 8 intended to be a 112, sixth paragraph recitation? Claim 9? In claim 10, what two structures, illustrated, are being referred to by "a resilient means" and "a deformable means"? Are these not the same elements? Is this then a

20 double recitation? Claims 13 and 8 are inconsistent in the recitation of "space reduction force" (claim 8) which results in a lack of proper antecedent basis of "said space reduction forces" in claim 13. It is noted that many of these issues have been raised in each of the parent cases. It is also noted that if applicant amends as he did in the parent cases, '499 in particular, 101 double patenting problems will arise,

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which are not curable by a Terminal Disclaimer. Take care to avoid these problems in your response.

5 *The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:*

10 *A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

15 *Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.*

20 *Claims 1, 3, 8-11, 13-15, 17, 20, and 22 are rejected under 35 U.S.C. § 103 as being unpatentable over Sawyer.*

Given the extreme indefiniteness of the claims, only a cursory attempt will be made to apply art thereto. As best as can be determined, Sawyer teaches applicant's device
25 ~~basis~~ broadly recited in claim 1 by the unit truss (figure 2) which comprises a resilient member and first and second end regions 5/6 which dilate the nose by the restoring force of the spring/resilient member. With regard to the recitation of a normally planar state, no difference is seen between this and the teachings of Sawyer to bend the device contrary to its natural state so as to generate a restoring force (page 1,
30 column 2). With regard to claim 3, note the lack of adhesive between end regions

5/6. The recitation of release liners to cover the adhesive members would have been obvious to one of ordinary skill in the art given the plethora of such arrangement in almost all arts. The substitution of one known spring material for another would also have been obvious to one of ordinary skill in the art, especially given the teachings of Sawyer in page 1, lines 68+. It would have been obvious to one of ordinary skill in the art at the time the invention was made as the simple evolution of the 1919 Sawyer device.

Claims 2, 4-7, 12, 16, 18, 19, and 21 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, to include all of the limitations of the base claim and any intervening claims; IF THEY ARE OF SCOPE DIFFERENT THAN THAT GRANTED IN THE PREVIOUS CASES, AND IF AN ACCEPTABLE TERMINAL DISCLAIMER IS FILED.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner K. L. Asher at telephone number (703) 308-0858.


Any inquiry of a general nature should be directed to the Group receptionist at (703) 308-0858.

Status inquiries are to be handled according to MPEP section 203, and directed to the Group receptionist, not the Examiner.

Inquiries as to Terminal Disclaimer and PCT requirements should be directed to the Group Paralegal, Mr. Andre Robinson, at (703) 308-2104.

*The facsimile phone number for Art Unit 3312 is (703) 308 - 3139. **PLEASE CALL THE EXAMINER PRIOR TO SENDING ANY FAX.** This will ensure that the Examiner receives the fax promptly.*

September 23, 1996


KIMBERLY L. ASHER
PRIMARY EXAMINER
GROUP 3300